

REMARKS

Claims 12-22 are pending. Claims 1-11 are cancelled.

Claims 12-22 are allowed.

Claims 1-4 have been rejected under 35 U.S.C. 102 as being anticipated by Ikeda. Dependent claims 7-11 have been rejected under 35 U.S.C. 103 as being unpatentable over Ikeda in view of Krause et al. Claims 5 and 6 are found allowable.

First, it is respectfully submitted that claims 1-11 were cancelled in the Request form for application under 37 CFR 1.53(b) filed on June 24, 2003. It is noted that the Filing Receipt mailed on August 18, 2003 acknowledges that 11 claims are pending.

Moreover, it is respectfully submitted that the applied prior art does not disclose the subject matter of the rejected claims 1-4 and 7-11 for the following reasons.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). When imposing a rejection under 35 U.S.C. § 102 for lack of novelty, the Examiner is required to specifically identify wherein an applied reference is asserted to identically disclose each and every feature of a claimed invention, particularly when such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Indeed, there are significant differences between the claimed apparatus vis-à-vis the apparatus disclosed by Ikeda

that scotch the factual determination that Ikeda discloses an apparatus identically corresponding to the claimed apparatus.

In particular, there are substantial differences between the claimed invention and Ikeda.

Claim 1 recites a data output apparatus for writing on a recording medium a data stream to be inputted and reading and sending out said data stream recorded on said recording medium to external device,

said data stream containing video-audio information compressed at a variable bit rate,

said data output apparatus comprising:

a first buffer for holding said inputted data stream;

writing means for writing on said recording medium said data stream held in said first buffer;

a second buffer for holding said data stream to be outputted to external device;

reading means for reading onto said second buffer said data stream held on said recording medium;

predicting means for predicting duration W to consume said data stream held on said the second buffer on the basis of the duration required for presentation of the video-audio information contained in said data stream held on said second buffer; and

control means for controlling said writing means and said reading means,

said writing means and said reading means writing or reading said data stream exclusively on said recording medium, and

said control means controlling said writing means and said reading means on the basis of the predicted duration W to consume said data stream to prevent said second buffer from underflow.

By contrast with the claimed invention, the reference discloses:

-Processing of constant bit rate (average bit rate) image data

-No predicting means

-The controller 23 controls the switch 15 to exchange the recording buffer memory 14 and the reproducing buffer memory 19 for a predetermined access time period (see Fig. 4A).

In particular, Ikeda is configured such that, the image data read from the optical disk 18 is stored on the reproducing buffer memory 19 during storing the recording buffer memory 14, and the data stored on the reproducing buffer memory 19 is inputted to the MPEG decoder 20 and reproduced on the monitor during the period that the image data is written from the recoding buffer memory 14 to the optical disk 18.

It is noted that in Ikeda, the writing rate for writing image data from digital video input section 13 to recording buffer memory 14, the reading rate for reading image data from recording buffer memory 14 to optical disk 18, the reading rate for reading image data from optical disk 18

to reproducing buffer memory 19, and the reading rate for reading from reproducing buffer memory 19 to MPEG decoder 20 are the constant bit rate (“average bit rate” in Ikeda).

As described above, in Ikeda, when the apparatus is designed, it is easy to calculate the consumption time for displaying specific dynamic image data from when the data is written into the reproducing the buffer memory 19. If the capacities of recording buffer memory 14 and reproducing buffer memory 19 are determined based on the calculation result, the displaying will not be interrupted as far as each bit rate is a predetermined value (the average bit rate). In this case, switch 15 exchanges recording buffer memory 14 and reproducing buffer memory 19 for a predetermined time period calculated in advance.

However, actual bit rate of the dynamic image changes at all times, and it is not constant. Therefore, under the configuration of Ikeda, the under-flow and over-flow appears in the reproducing buffer memory 19, which causes the interruption of reproducing the images.

The examiner indicates in the detailed action that controller 23 of Ikeda corresponds to predicting means in the present application. But, controller 23 handles the constant bit rate, such as 4Mbps and 12Mbps (column 6, lines 3-15). Additionally, in column 7, line 66 to column 9, line 40, controller 23 only controls recording buffer memory 14, reproducing buffer memory 19, and driver 24 for a predetermined specific time. Therefore, one skilled in the art would understand that the controller 23 does not correspond to the claimed predict means.

Accordingly, claim 1 is clearly defined over the reference. Moreover, claims 2-4 and 7-11 depend from claim 1. Therefore, they are defined over the prior art at least for the reasons presented above in connection with claim 1.

In view of the foregoing, and in summary, the present application is in condition for allowance. Favorable reconsideration of this application is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.



Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Alexander V. Yampolsky
Registration No. 36,324

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 AVY:MWE
Facsimile: 202.756.8087
Date: September 18, 2007

**Please recognize our Customer No. 20277
as our correspondence address.**